

Serial No. 09/681,099
Filed: January 4, 2001
Page 7 of 14

Examiner: Joseph C. Merke
Group Art Unit: 3727

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of the extension portion and the insert portion forms a shoulder that abuts the open top to limit the insertion of the collar into the sleeve when the cup is received within the sleeve.

REMARKS

Claims 1-51 are pending in the application. By this amendment, claims 33, 39, 40, 41, 44, 47-51 are canceled from the application. New claims 52-80 are added to the application. Claim 52 replaces claim 39 and combines the friction enhancer concept of claim 44 with the sleeve concept of claim 39. Claim 53 combines the slot concept of claim 51 with the sleeve concept of claim 39. Claim 62 is essentially claim 18 rewritten in independent form, which was indicated as allowable subject matter. Claim 68 is essentially claim 32 combined with the slot concept. Claim 75 is essentially 31 rewritten in independent form, which was indicated as allowable. No new matter is added to the application by these amendments.

Reconsideration and reexamination of the application is respectfully requested.

Applicant would initially like to thank the Examiner for the early indication of allowable subject matter. Such indication should prove useful in expediting the prosecution of the application.

Claim 33 is objected to because it contained the same limitation as found in the corresponding base claim. Claim 33 is canceled from the application without prejudice thereby obviating the basis for the objection.

Claims 17, 39-51 are rejected as being indefinite. The rejection is traversed.

Claim 17 is amended to change its dependency to claim 9 and clarify that the friction enhancer is a longitudinal rib. It is respectfully submitted that the amendments to the claim address the antecedent basis rejection.

Claims 39-51 are rejected for apparently describing features of the sleeve in the context of the environment for the sleeve. It is respectfully submitted that it is proper to describe a claim element in the context of the corresponding environment. Regardless, claim 39 is replaced by claim 52 and claims 40, 41, 44, and 47-51 are canceled from the application. It is submitted that these changes to the claims address the rejection.

Serial No. 09/681,099
Filed: January 4, 2001
Page 8 of 14

Examiner: Joseph C. Merke
Group Art Unit: 3727

Rejections under 35 USC §102(b)

The Examiner has rejected claims 39-46 and 51 as anticipated by U.S. Patent No. 1,035,718 to Marsters et al., U.S. Patent No. 3,592,501 to Stokes et al., and U.S. Patent No. 4,747,507 to Fitzgerald et al. These rejections are respectfully traversed.

Marsters discloses a metal or glass cup holder 1 for supporting an inexpensive flexible cup 4, which has a lip that overhangs the upper edge of the cup holder. The cup holder 1 has openings or holes 3 in a bottom wall. The inexpensive flexible cup can be economically disposed of after use and a fresh cup inserted into the cup holder for a subsequent user, thereby providing an inexpensive multiple-use cup while eliminating the need to clean the cup after each use. The inner surface of the metal or glass cup holder is shown as being smooth and of a continuous uninterrupted surface.

Stokes, like Marsters, discloses a cup holder for holding a disposable cup. The Stokes cup holder comprises a platform 11 and curved arms 16, 17, which are connected to a handle 25. The inner surface of the arms is shown as being smooth, with an uninterrupted surface.

Fitzgerald discloses a bottle cap remover made from injection molded plastic and having a bottom wall 6 from which extends a smooth peripheral wall from which ribs 18 project. The bottom wall includes a hole 8, which has diameter of approximately 29 mm (just slightly larger than one inch) to receive a crown seal (bottle cap) of a conventional size. (Col. 1, line 66 to Col. 2, line 6). A series of ribs 10 are provided and are arranged to fall within the grooves defined by the crown seal. To remove the crown seal/bottle cap, the TOP of the bottle with the crown seal is inserted into the body 2 until the crown seal/bottle cap is received within the hole 8 and the ribs 10 nest between the grooves in the crown seal/bottle cap. The body is then rotated to remove the crown seal/bottle cap from the top of the bottle.

Claims 39-51 all relate solely to a sleeve used in a confection cup assembly. Claim 39 was the only original independent claim directed solely to the sleeve. Claims 39-41, 44-51 have been cancelled without prejudice, obviating the basis for the anticipation rejection of these claims.

Serial No. 09/681,099
Filed: January 4, 2001
Page 9 of 14

Examiner: Joseph C. Merke
Group Art Unit: 3727

New independent claims 52 and 53 are directed to the sleeve of a confection cup assembly. New claims 52 and 53 do not claim the cup or the collar of the confection cup assembly but reference those elements in functional language to describe the environment for the sleeve.

New claim 52 replaces original claim 39 and calls for a sleeve with a friction enhancer. New claim 53 calls for a sleeve with at least one longitudinal slot extending through a peripheral of the sleeve. None of Marsters, Stokes, or Fitzgerald disclose a sleeve with a friction enhancer or a longitudinal slot and are not anticipated by Marsters, Stokes, or Fitzgerald.

In the Office Action, it is asserted that the inner surface of Marsters, Stokes, and Fitzgerald qualifies as a friction enhancer. The assertion is not supportable in light of the specification and the normal meaning of the term enhance/enhancer. From the specification it is clear that the term friction enhancer is used to reference a structure that provides friction greater than what is naturally associated by the inner surface of the sleeve. Thus, the claimed friction enhancer increases the friction between the cup and the sleeve when the cup is inserted into the sleeve. This is a normal usage of the term enhance in that the term friction enhancer connotes that the friction is quantitatively increased over the inherent frictional resistance of the inner surface alone. Thus, the inner surface of structure of Marsters, Stokes, and Fitzgerald does not, by definition, satisfy the claimed element of a friction enhancer. The asserted interpretation of the friction enhancer as used in the claims ignores its plain and clear meaning as used in the specification and is improper. Therefore claim 52 is not anticipated by Marsters, Stokes, or Fitzgerald.

Claims 42 and 43 are also not anticipated because of their direct or indirect dependency on claim 52.

Claim 42 is further not anticipated by Stokes since Stokes does not disclose the claimed openings in the bottom wall of the cup holder.

Claims 52, 42, 43, 45, 46 are further not anticipated by Fitzgerald because Fitzgerald does not disclose the claimed sleeve. Applicant respectfully submits that the Fitzgerald reference

Serial No. 09/681,099
Filed: January 4, 2001
Page 10 of 14

Examiner: Joseph C. Merke
Group Art Unit: 3727

was incorrectly interpreted when making the rejection. Fitzgerald discloses a device for removing a crown seal or bottle cap from the top of a bottle. Fitzgerald has an opening in the bottom wall that is specifically shaped to receive the crown seal. Fitzgerald is not a sleeve for receiving a cup as called for by claim 52.

Rejections under 35 USC §103(a)

Claims 47-49 stand rejected under 35 USC 103(a) as being obvious over Marsters in combination with Amberg. The rejection is moot since claims 47-49 are canceled from the application without prejudice.

Claims 47, 49 and 50 stand rejected under 35 USC 103(a) as being obvious over Marsters in view of Fitzgerald. The rejection is moot since claims 47-49 are canceled from the application without prejudice.

Claims 1-12, 19-29 and 32-37 stand rejected under 35 USC 103(a) as being obvious over Marsters in view of FR 1,437, 341. The rejection is traversed.

FR '341 discloses a cup 1 comprising a lid/baffle 5 and a cover 9 with a drinking spout 12. The lid/baffle 5 has a portion 6 that is received within the cup 1. The cover 9 has a portion 10 that is received within the top of the lid/baffle 5. A series of openings are formed in the lid/baffle 5 and retard the flow of liquid from the cup and into the cover 9 to prevent liquid from rapidly flowing out of the cup 1 and through the spout 12 when the cup is tipped for drinking. The FR '341 is akin to a child's sippy cup with a baffle for slowing the flow of liquid through the spout.

The combination of the Marsters and FR '341 is traversed on multiple grounds. First, the FR '341 patent is non-analogous art. The FR '341 patent is not within the field of Applicant's invention. The FR '341 patent is directed to spill-proof or spill resistant cups and is not a confection cup assembly or any part of a confection cup assembly. The FR '341 patent is not directed to solving the same problem as Applicant's invention: the retardation of the tendency of the cup to rotate in a sleeve. The problem solved by the FR '341 patent is that of spilling of the liquid from a cup.

Second, assuming, *arguendo*, that the FR '341 patent is analogous art, then there is no teaching or suggestion to combine the references. Since the FR '341 patent only discloses a cup

Serial No. 09/681,099
Filed: January 4, 2001
Page 11 of 14

Examiner: Joseph C. Merke
Group Art Unit: 3727

and no sleeve, there is no teaching or suggestion in the reference to add a sleeve to hold the cup. It is asserted in the Office Action that the collar of the FR '341 patent can be added to the Marsters patent. This position is not tenable in that there is no teaching or suggestion in either reference to make the combination. The Marsters patent does not need a collar to hold the cup in the cup holder. The addition of a collar to the Marsters patent is not even relevant to the function of the Marsters cup holder.

The rejection does not meet the requirements for a prima facie case of obviousness. It is known that "[w]hen patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of *whether there is teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness*. See, e.g., *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52, 60 USPQ2d 1001, 1008 (Fed. Cir. 2001) ("the central question is whether there is reason to combine [the] references," a question of fact drawing on the *Graham v. John Deere* factors) (*emphasis added*). Here, there is no reason to combine the references. No evidence of teaching, suggestion or motivation to combine the asserted references is offered in the office action. Absent the identification of such motivation expressly contained in the references making up the combination, the alleged combination is nothing but an exercise in impermissible prior-art-based hindsight reconstruction of Applicants' claimed invention. See *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) ("Our case law makes clear that the best defense against the *subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.*") (*emphasis added*).

It is submitted that the only basis for attempting to add the collar of the FR '341 patent with the Marsters patent is that of hindsight reconstruction because a collar is needed to reach the claimed invention and a collar is not taught by the cited prior art.

If for some reason the combination could be made, it would, at best, teach the cup holder and cup of Marsters with either the lid/baffle 5 or cover 9 closing the top of the Marsters cup. However, either of these approaches necessarily closes off the top of the cup of the Marsters cup since both the lid/baffle 6 and cover 9 are lids and not a collar as claimed. In

Serial No. 09/681,099
Filed: January 4, 2001
Page 12 of 14

Examiner: Joseph C. Merke
Group Art Unit: 3727

other words, the alleged combination really teaches adding a lid to the Marsters cup and cup holder. Thus, the alleged combination does not have a collar as claimed since access cannot be made to the interior of the cup with the alleged combination.

Claims 14-16, 30, 38 stand rejected under 35 USC 103(a) as being obvious in view of the combination of Marsters and FR '341 and further in view of Smith et al. The rejection is traversed.

Smith et al. discloses a funnel-like object having a neck 24 that is received within the mouth of a bottle. The funnel-like object includes a seal/gasket on the neck to seal the funnel-like object with respect to the bottle upon insertion and permit one to drink from the bottle through the funnel-like object.

The addition of Smith to the prior combination of Marsters and FR '341 is traversed. As with the FR '341 patent, the Smith patent is non-analogous art. Smith is nothing more than a drinking aid to enlarge the drink opening of a bottle and is in no way within the field of applicants invention of a confection cup assembly. Neither is Smith concerned with solving the problem of preventing the cup from rotating relative to the sleeve. Smith solves the problem of how to drink from a bottle as if you were drinking from a cup.

Also, as with FR '341 there is no teaching or suggestion to add Smith to the combination. The addition of Smith to the combination appears to be based solely on the need to find some type of annular rib in an attempt to reach the claimed ribs, instead of any teaching or suggestion in the references themselves. This is classic hindsight reconstruction and is not permissible.

Moreover, the addition of Smith does not address the shortcomings of the combination of Marsters and the FR '341 patent. Therefore, the combination of Marsters, FR '341 and Smith is not tenable because the underlying combination of Marsters and FR '341 cannot be made for the reasons previously described.

Assuming, arguendo, that the alleged combination was made, it would disclose the previous combination with the gasket/rib of Smith circumscribing the lid/baffle 5 or the cover 9 functioning as a lid for the cup and cup holder of the Marsters. Such a combination does not disclose the claimed sleeve and collar of the claimed invention.

Serial No. 09/681,099
Filed: January 4, 2001
Page 13 of 14

Examiner: Joseph C. Merke
Group Art Unit: 3727

Claims 17 and 30 are rejected under 35 USC 103(a) as being obvious over Marsters in view of FR '341 and Smith and further in view of Fitzgerald. The rejection is traversed.

The rejection fails because the underlying combination is not tenable for the reasons previously stated.

Fitzgerald is also non-analogous art. It is crown seal/bottle cap remover and is not within the same field of endeavor as Applicant's invention. It is directed to the problem of removing a crown seal/bottle cap from the bottle and not to preventing the rotation of a cup in a sleeve.

Fitzgerald is cited for disclosing ribs to retain the cup. A close reading of Fitzgerald will disclose that the ribs perform no such function. Again, it appears that Fitzgerald was added to combination in an attempt to reach the claims at issue without any teaching in the reference to make the combination as asserted. This is impermissible hindsight reconstruction.

Claims 1-7, 9-13, 19-24, 26-29, and 32-37 stand rejected under 35 USC 103(a) as being obvious over Marsters in view of Schmiedeknecht. The rejection is traversed.

Schmiedeknecht discloses an extension ring B for a cup to keep the consumer's lips from contacting the glass A.

The combination of Schmiedeknecht with Marsters is traversed. Schmiedeknecht, like the other references, is non-analogous art. It is not in the same field of endeavor as Applicant's invention and it is directed to solving a totally different problem. Moreover, there is no teaching or suggestion to make the combination. Marsters uses a disposable cup and would have no need for the sanitary extension ring disclosed in Schmiedeknecht. Likewise, there is no need for the Schmiedeknecht reference to include a disposable cup as shown in Marsters.

The combination is based solely on hindsight reconstruction. The examiner has failed to provide a prima facie case of obviousness.

Claims 14-16, 30, 38 stand rejected under 35 USC 103(a) as being obvious over Marsters in view of Schmiedeknecht and further in view of Smith. The rejection is traversed. The rejection must fail because the combination is improper. The combination initially fails for the reasons stated above regarding the combination of Marsters and Schmiedeknecht. The combination further fails in that, as described above, Smith is non-analogous art. Additionally,

Serial No. 09/681,099
Filed: January 4, 2001
Page 14 of 14

Examiner: Joseph C. Merke
Group Art Unit: 3727

there is no teaching or suggestion to make combine Smith with either Marsters or Schmiedeknecht, other than impermissible hindsight reconstruction.

Claims 17 and 30 stand rejected under 35 USC 103(a) as being obvious over Marsters in view of Schmiedeknecht and Smith and further in view of Fitzgerald. The rejection is traversed. The combination initially fails for the reasons stated above regarding the combination of Marsters and Schmiedeknecht and Smith. The combination further fails in that, as described above, Fitzgerald is non-analogous art. Additionally, there is no teaching or suggestion to make combine Fitzgerald with either Smith, Marsters or Schmiedeknecht, other than impermissible hindsight reconstruction.

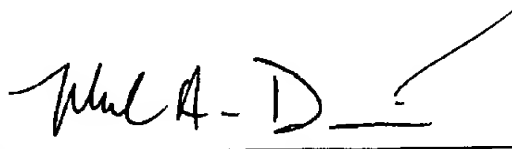
All of the claims in the application are allowable over the prior art of record for the reasons stated above. Early notification of allowability is respectfully requested.

Respectfully submitted,

Dated:

4/17/02

By:



Mark A. Davis (Reg. No. 37,118)
McGARRY BAIR LLP
171 Monroe Avenue, NW, Suite 600
Grand Rapids, Michigan 49503
616-742-3500

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APPENDIX A

17. (Amended) The confection cup assembly according to claim 914, wherein the ~~protrusion~~-friction enhancer is a longitudinal rib extending away from an interior surface of the sleeve.

33. Canceled.

34. (Amended) The confection cup assembly according to claim 3233, and further comprises a friction enhancer provided on at least one of the collar and sleeve.

39. Canceled

40. Canceled

41. Canceled

42. (Amended) The sleeve according to claim 5239, wherein the bottom wall of the sleeve comprises at least one air passage extending therethrough.

43. (Amended) The sleeve according to claim 5239, wherein the sleeve body tapers in a direction away from the open top.

44. Canceled

45. (Amended) The sleeve according to claim 5244, wherein the friction enhancer is provided on the sleeve adjacent the upper edge.

46. (Amended) The sleeve according to claim 5245, wherein the ~~friction enhancer~~ comprises a frictional material is rubber.

47. Canceled

48. Canceled

49. Canceled

50. Canceled

51. Canceled

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